

**REMARKS/ARGUMENTS**

Applicant thanks the Examiner for the courtesy of several telephonic interviews. As discussed in the telephonic interviews, in the copy of the Information Disclosure Statement by Applicant returned with the Office Action dated November 3, 2006, reference number GB 2 235 800 A under the list of foreign patent documents was not initialed by the Examiner as having been considered. Request is hereby made for consideration of this reference if it has not already been considered, and enclosure in the next official communication of another copy of the Information Disclosure Statement bearing the Examiner's initials, indicating that reference number GB 2 235 800 A has been considered.

In the last Office Action, dated March 20, 2007, all pending claims were rejected over prior art as either anticipated or obvious under 35 USC 102 and 103. In addition, Claims 1 and 6 were objected to for informalities.

With respect to informalities, the Amendment changes "external vehicle computer" to "external computer" in Claims 1 and 22, and the first instance of "the terminal" in Claim 6 has been revised to "a terminal". Finally, a period has been added to the end of Claim 24. The foregoing revisions are made to correct informalities, not for a substantial reason related to patentability and do not narrow the claims.

Concerning prior art rejections, Claim 1 was rejected as obvious over US Patent No. 4,530,067 to Dorr in view of US Patent No. 5,311,302 to Berry et al., hereinafter referred to respectively as "Dorr" and "Berry". Dorr discloses a restaurant at Col. 3, lines 10-20, in which waiters are equipped with remote units (10). In particular, the remote units (10) "are small portable units that can be held in the hands of a waiter." According to Col. 3, lines 21-36 and Fig. 1 of Dorr, the waiter remote units communicate via radio frequency with an interrogator transceiver (40) in the restaurant, with the interrogator transceiver being coupled to a central processor (42).

1 Based on this disclosure, the Office Action asserts that Dorr teaches "an onboard  
2 computer, and an external computer not transported with the vehicle" as recited in Claim 1 of  
3 the present application. According to the telephonic interviews, the Examiner considers the  
4 central processor (42) in Dorr to be an onboard computer and the waiter remote units (10) to  
5 be an external computer not transported with the vehicle.

6 The Examiner concedes that Dorr does not teach that the central processor (42) is  
7 transported with the vehicle. For this purposed, the Office Action cites Berry, which discloses  
8 an interactive video entertainment and data management system (10) for a passenger vehicle,  
9 such as an aircraft. In particular, Berry teaches at Col. 3, lines 4-11, providing a central  
10 terminal (12) with a remote video terminal mounted in the seatback (16) of each passenger  
11 seat in an aircraft.

12 The Office Action asserts that it would have been obvious to one of ordinary skill in  
13 the art to modify Dorr to include an onboard computer as taught by Berry and that this  
14 combination would meet all of the recitations of Claim 1. Applicants respectfully traverse this  
15 obviousness rejection of Claim 1 and request reconsideration and withdrawal of the rejection  
16 for the following reasons.

17 Section 2142 of the MPEP provides that "[t]he examiner bears the initial burden of  
18 factually supporting any *prima facie* conclusion of obviousness" (emphasis in original).  
19 MPEP 2142 further provides that there are three basic requirements that must be met to  
20 establish a *prima facie* case of obviousness:

21 First, there must be some suggestion or motivation, either in the references themselves or in the  
22 knowledge generally available to one of ordinary skill in the art, to modify the reference or to  
23 combine reference teachings. Second, there must be a reasonable expectation of success.  
Finally, the prior art reference (or references when combined) must teach or suggest all the  
claim limitations.

24 With respect to the suggestion or motivation for combining the teachings of Dorr and  
25 Berry, the Office Action asserts without citation to support in Dorr or Berry that "one would  
26 have been motivated to do this in order to provide a commercial transport passenger [vehicle]

with a computer for ordering of goods/services." However, the asserted motivation is not credible as is evident from Fig. 2 of Berry reproduced below:

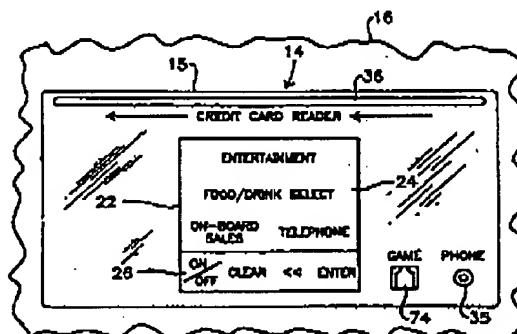


Fig.2

As can be seen from the foregoing figure, Berry provides "ON-BOARD SALES" and thus already provides "a commercial transport passenger [vehicle] with a computer for ordering of goods/services". One of ordinary skill in the art interested in providing "a commercial transport passenger [vehicle] with a computer for ordering of goods/services" would simply rely on Berry and would not be motivated to modify Dorr as asserted in the Office Action. Therefore, there is no motivation to modify Dorr based on Berry as asserted in the Office Action.

As stated in MPEP 2142, quoting from *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) (emphasis added):

To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a *convincing line of reasoning* as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

As Berry "provides a commercial transport passenger [vehicle] with a computer for ordering of goods/services", the line of reasoning presented in the Office Action for the combination is not convincing.

The only motivation to combine Dorr and Berry appears to be based upon the invention defined by Claim 1, not any express or implied teachings in the cited art or

1 knowledge generally available to a person of ordinary skill in this technology field. As  
2 further stated in MPEP 2142:

3 The teaching or suggestion to make the claimed combination and the reasonable expectation  
4 of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947  
F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

5 Further according to MPEP 2142 "impermissible hindsight must be avoided and the legal  
6 conclusion must be reached on the basis of the facts gleaned from the prior art." In this  
7 situation no credible reason has been provided for a suggestion or motivation for the asserted  
8 combination.

9 Moreover, according to MPEP 2143.01, "[i]f [the] proposed modification would  
10 render the prior art invention being modified unsatisfactory for its intended purpose, then  
11 there is no suggestion or motivation to make the proposed modification." The intended  
12 purpose in Dorr for the waiter remote units (10) is for the waiter to manually enter a  
13 food/drink order from a patron in which the waiter remote unit (10) automatically guides the  
14 waiter through an order taking sequence as explicitly set forth in Claim 1 of Dorr. Thereafter,  
15 the unit (10) remotely communicates the information via radio frequency to the kitchen for  
16 preparation of the order and pickup by the waiter for delivery to the patron (see Col. 4, line 8  
17 to Col. 5, line 51 of Dorr). In serving a table, the waiters use the remote units (10) to record  
18 the table and seat numbers for the patrons at that table as described at Col. 4, lines 8-30 of  
19 Dorr.

20 Modifying Dorr to convert the remote units (10) to "an external computer not  
21 transported with the vehicle" as recited in Claim 1 of the present application would render the  
22 prior art invention in Dorr unsatisfactory for its intended purpose. Namely, the waiters or  
23 flight attendants would not be able to take orders from patrons because the waiters or flight  
24 attendants using remote units (10) external to the vehicle would be separated from the patrons  
25 seated in the vehicle. Furthermore, the waiters or flight attendants would not be able to  
26 deliver the orders to the passengers. Accordingly, there is no suggestion to modify the

1 teachings of Dorr as stated in the Office Action because the asserted modification renders the  
2 prior art invention of Dorr unsatisfactory for its intended purpose.

3 The second requirement for establishing a prima facie case of obviousness as provided  
4 in MPEP 2143 is that "there must be a reasonable expectation of success." The modification  
5 asserted in the Office Action of Dorr does not meet this requirement. A handheld portable  
6 unit (10) as taught by Dorr that is "an external computer not transported with the vehicle" of  
7 Berry would not have "a reasonable expectation of success" in being able to communicate  
8 with the vehicle except when in close proximity thereto, which would defeat the purpose of  
9 applying the system to a transport vehicle.

10 The last requirement for establishing a prima facie case of obviousness as provided by  
11 MPEP 2142 is that (emphasis added) "the prior art reference (or references when combined)  
12 must teach or suggest *all* the claim limitations." The asserted combination of Dorr and Berry  
13 does not meet this requirement.

14 Specifically, Claim 1 of the present application recites software operable on the  
15 external computer "for causing the external computer to perform tasks including...managing  
16 the delivery of services to the transport vehicle". There is no teaching or suggestion in Dorr  
17 of the waiter remote units "managing the delivery of services to the transport vehicle". To the  
18 contrary, Dorr teaches that the waiter remote units (10) facilitate the delivery of services from  
19 the kitchen or bar of a restaurant to patrons seated at tables within the restaurant, not a  
20 transport vehicle. Therefore, even if there was a suggestion to combine Dorr and Berry as  
21 asserted in the Office Action, the asserted combination still would not meet all of the  
22 recitations of Claim 1.

23 As stated in MPEP 2142.01(VI) (emphasis in original), "[a] prior art reference must  
24 be considered in its entirety, i.e., as a whole, including portions that would lead away from  
25 the claimed invention." The suggestion in Dorr to a person of ordinary skill in the art  
26 interested in applying the system to an aircraft as disclosed in Berry, is to transport the waiter

1 remote units (10) onboard the aircraft contrary to the recitation in Claim 1 of the present  
2 application of "an external computer not transported with the vehicle".

3 Specifically, the personnel onboard a commercial transport vehicle as in Berry that  
4 correspond most closely to waiters in a restaurant are flight attendants. In particular, the flight  
5 attendants are the personnel that provide food service to the passengers and who travel with  
6 the vehicle. More particularly, Dorr teaches that the waiter remote units (10) are carried by  
7 waiters. Hence, the suggestion in Dorr to a person of ordinary skill in the art interested in  
8 applying the teachings to a vehicle is that the remote units (10) would be transported with the  
9 vehicle. Dorr therefore teaches away from the claimed invention. As discussed in  
10 MPEP 2145, "[a] prior art reference that 'teaches away' from the claimed invention is a  
11 significant factor to be considered in determining obviousness".

12 For the reasons discussed above, reconsideration and withdrawal of the obviousness  
13 rejection of Claim 1 is respectfully requested. Likewise, the same is requested for Claims 2-6,  
14 which each depend directly or indirectly from Claim 1, and therefore are non-obvious over  
15 the cited prior art for at least the same reasons as Claim 1.

16 Regarding the rejection of Claim 7, the above Amendment revises Claim 7 to more  
17 clearly define and distinguish over the prior art. In the Office Action, Claim 7 was rejected  
18 under 35 USC 102(b) as anticipated by Berry.

19 MPEP 706.02(IV) provides that "for anticipation under 35 U.S.C. 102, the reference  
20 must teach every aspect of the claimed invention either explicitly or impliedly. Any feature  
21 not directly taught must be inherently present." Further in support of this requirement,  
22 MPEP 2131 quotes the Court of Appeals for the Federal Circuit in *Richardson v. Suzuki*  
23 *Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (1989) stating that "[t]he identical  
24 invention must be shown in as complete detail as is contained in the . . . claim."

25 Claim 7 as amended above, recites in pertinent part "providing a menu adapted for  
26 individual passengers that varies based on explicit preordering and historical preference". As

1 discussed in the telephonic interviews, Berry does not teach or suggest this recitation. Berry  
2 therefore does not show the identical invention "in as complete detail as is contained in the . . .  
3 claim." Accordingly, it is respectfully submitted that the rejection of Claim 7 as anticipated  
4 by Berry has been overcome.

5 Claim 8 was also rejected as anticipated by Berry. However, as acknowledged by the  
6 Examiner during the telephonic interviews, Berry does not disclose electronic devices as  
7 recited in Claim 8 that "include passenger supplied personal information processing  
8 apparatus carried on by passengers". Therefore, Berry does not show the identical invention  
9 "in as complete detail as is contained in the . . . claim" and Claim 8 distinguishes over Berry.  
10 The above amendment revises Claim 8 to independent format, and it is therefore submitted  
11 that Claim 8 has been placed in an allowable condition.

12 Due to the revisions of Claims 7 and 8 by the Amendment, reconsideration and  
13 withdrawal of the rejection of each claim as anticipated by Berry is respectfully requested.  
14 Reconsideration and withdrawal of the prior art rejections of each of Claims 9-15 is also  
15 requested since each of these claims depend directly or indirectly from one of Claims 7 or 8.

16 Regarding the rejection of Claim 9, the above amendment revises Claim 9 to more  
17 clearly define and distinguish over the prior art. Namely, the Amendment revises Claim 9 to  
18 replace "electronic devices" with "passenger supplied personal information processing  
19 apparatus carried on by passengers". There is no teaching or suggestion in the cited prior art  
20 of connections comprising wireless communication between passenger supplied personal  
21 information processing apparatus carried on by passengers and an onboard computer.

22 With respect to the assertion of Official notice in the Office Action "that it is old and  
23 well known to use wireless communication technology between two electronic devices", this  
24 assertion of Official notice is hereby traversed pursuant to 2144.03.

25 The present application has an effective US filing date of April 19, 1999 based upon  
26 a provisional application. The proper standard in concluding whether something "is old and

1 well known" is whether it was old and well known prior to April 19, 1999. According to  
2 MPEP 2144.03 (emphasis added):

3 Official notice unsupported by documentary evidence should only be taken by the examiner  
4 where the facts asserted to be well-known, or to be common knowledge in the art *are capable*  
5 *of instant and unquestionable demonstration as being well-known.*

6 Claim 9 does not merely recite using "wireless communication technology between  
7 two electronic devices". As amended, the claim recites connections comprising (emphasis  
8 added) "wireless communication between the passenger supplied personal information  
9 processing apparatus carried on by passengers and the *onboard computer.*"

10 Wireless communication between passenger supplied personal information  
11 processing apparatus carried on by passengers and an onboard computer is not "capable of  
12 instant and unquestionable demonstration as being well-known" in the 1990's. If it were,  
13 Berry, which has a filing date of July 2, 1992, should have disclosed the subject matter. As  
14 acknowledged in the Office Action, "Berry does not teach wireless communication."

15 Even assuming arguendo "that it is well known and old to use wireless  
16 communication technology between two electronic devices", it is not well known to use such  
17 technology "between passenger supplied personal information processing apparatus carried  
18 on by passengers and [an] onboard computer."

19 Since Claim 9 depends from Claim 8, Claim 9 therefore further distinguishes over the  
20 cited art in addition to the reasons already discussed for Claim 8. Accordingly,  
21 reconsideration and withdrawal of the rejection of Claim 9 is respectfully requested. The  
22 same is requested for Claim 10 as Claim 10 depends from Claim 7 and therefore  
23 distinguishes over the cited art for at least the same reasons as Claim 7.

24 The Official notice taken with respect to Claim 11 is traversed for the same reasons  
25 as discussed for Claim 9. Claim 11 does not merely recite using "wireless communication  
26 technology between two electronic devices". Rather, Claim 11 recites wireless  
communication "between the handheld computers and the onboard computer". Accordingly,



1 reconsideration and withdrawal of the rejection of Claim 11 is respectfully requested. The  
2 same is requested for Claims 12-14, which each depend directly or indirectly from Claim 7  
3 and therefore distinguish over the cited prior art for at least the same reasons as Claim 7.

4       Concerning Claim 15, the Office Action takes "Official notice . . . that it is old and  
5 well known to provide Internet access at a passenger seat location corresponding to the  
6 service order." Pursuant to 2144.03, this assertion of Official notice is hereby traversed. As  
7 discussed previously, the present application has an effective US filing date of April 19, 1999.  
8 In this situation, the proper standard in concluding whether something "is old and well  
9 known" is therefore whether it was old and well known prior to April 19, 1999.

10       The subject matter in question is not capable of instant and unquestionable  
11 demonstration as being well known in the 1990's. If it were, Berry should have disclosed the  
12 subject matter. Berry has a filing date of July 2, 1992 and is directed to an entertainment and  
13 data management system for a passenger vehicle including individual seat interactive video  
14 terminals. Based on the subject matter that Berry is directed to, one would expect the patent  
15 to have disclosed providing Internet access at a passenger seat location corresponding to a  
16 service order if this subject matter was old and well known in the art.

17       In addition, currently pending Claim 15 does not merely recite providing "Internet  
18 access at a passenger seat location corresponding to the service order". Rather, the claim  
19 recites in pertinent part that (emphasis added) "*the onboard computer provides* Internet  
20 access to a connection at a passenger seat location corresponding to the service order".  
21 Therefore, even if it is were well known and old to provide Internet access at a passenger seat  
22 location corresponding to a service order, it is not old and well known for this to be provided  
23 by an onboard computer as recited in Claim 15.

24       Finally, if such subject matter is indeed capable of instant and unquestionable  
25 demonstration as being well-known prior to the US effective filing date of the present  
26

1 application, it should not be difficult to locate and cite prior art documents supporting the  
2 rejections that were made on the basis of Official notice.

3 Turning to the last independent claim, Claim 16 was rejected in the Office Action as  
4 obvious over Dorr and Berry combined with two other prior art references: (1) US Patent  
5 No. 5,845,263 to Camaisa et al. and (2) US Patent No. 6,122,620 to Weber. The above  
6 Amendment revises Claim 16 to more clearly define and distinguish over the prior art. In  
7 particular, the Amendment revises Claim 16 to additionally recite "providing a menu adapted  
8 for individual passengers based on explicit preordering and historical preference." As  
9 discussed in the telephonic interviews, the cited prior art does not teach or suggest this and  
10 therefore Claim 16 as amended distinguishes over the prior art.

11 Finally, the above Amendment adds one new Claim 25, depending from Claim 1.  
12 Claim 25 recites the system as "further comprising handheld computers used by vehicle  
13 personnel for creating and accessing service orders on the onboard computer by  
14 communication between the handheld computers and the onboard computer." Claim 25 thus  
15 further distinguishes over the cited art and recites handheld computers in addition to external  
16 and onboard computers as recited in Claim 1. Claim 25 is thus respectfully submitted to be in  
17 an allowable condition.

1 **CONCLUSION**

2 In view of the discussion above, it believed to have been shown that all of the claims  
3 distinguish over the cited prior art. Pursuant to 37 CFR 1.112, reconsideration and re-  
4 examination of the application is therefore accordingly requested, and withdrawal of the  
5 objections and rejections and allowance of the claims.

6 If possible, applicant would like to avoid an appeal. If it is necessary, as a final step,  
7 applicant would appreciate a review of the claims in the above Amendment by a supervisory  
8 or primary Examiner for the presence of patentable subject matter. If there are any questions,  
9 please contact the undersigned representative for applicant.

10 Respectfully submitted,

11   
12 Brian P. Furrer, USPTO Reg. No. 37,627